

REMARKS

1. In response to the Office Action mailed August 14, 2009, Applicants respectfully request reconsideration. Claims 1, 3, 5-8, 10-12, 14-17, 68 were last presented for examination. In the outstanding Office Action, claims 1, 3, 5-8, 10-12 and 14-17 have been rejected. By the foregoing Amendments, claims 3, 5, 12 and 17 have been amended, claim 8 has been cancelled, and no claims have been added. Thus, upon entry of this paper, claims 1, 3, 5-7, 10-12, 14-17 and 68 will be pending in this application. Of these thirteen (13) claims, one (1) claim (claim 1) is independent.

2. Based on the above Amendments and the following Remarks, Applicants respectfully request that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

Claim Rejections Under 35 U.S.C. §112, First Paragraph

3. The Examiner rejected claims 6-8, 17 and 68 under 35 U.S. C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner states that the above claims contain subject matter which is not described in the specification in such a way as to enable one skilled in the art to make and/ use the invention. (*See*, Office Action, pg. 2.)

4. Specifically, according to the Examiner, the phrases "chassis and wall of a housing of an implantable component" as recited in claims 6-8, "encapsulating" recited claim 17, and "a housing of an implantable component" as recited in claim 68 are not described in the specification and/or drawings in such a way as to enable one skilled in the art to make and/or use the invention. (*See*, Office Action, pg. 2.) Applicants respectfully disagree.

5. According to the Manual of Patent Examining Procedure (MPEP), "[a]ny analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention . . . Any part of the specification can support an enabling disclosure." (*See*, MPEP § 2164.01; emphasis added.) For at least the following reasons, Applicants assert that the specification discloses sufficient information to enable one skilled in the pertinent art to make and use the claimed invention without undue experimentation.

6. Regarding the phrase “chassis and wall of a housing of an implantable component” recited in claims 6-8, the present specification clearly provides sufficient information to satisfy the enablement requirement of Section 112. Specifically, the specification states that “[t]he feedthrough member is adapted to provide electrical connection through **the chassis or wall of the housing whilst also ensuring hermetic sealing of the housing**” and that “the feedthrough member 11 **is mountable in a wall or chassis of a housing 14 and comprises a first portion 15 and a second portion 16.**” Moreover, as described throughout the specification text and shown in the figures, the antenna is used as an element of an **implantable component**. (See, Applicants Published Application, paras. [0016] and [0107]; FIG. 1a; emphasis added.) Furthermore, it is known to one of ordinary skill in the art that a feedthrough is a component which provides an electrical connection through another component. Based on this fact, as well as based on the above excerpts of Applicants’ disclosure as filed, Applicants assert there is sufficient information to find that one of ordinary skill in the art find that the phrase “chassis and wall of a housing of an implantable component” is enabled.

7. Applicants’ specification states that “the method can further include the step of **encapsulating the housing, feedthrough and antenna in an electrically insulating material.**” (See, Applicants’ Published Application, paras. [0067]-[0068] and [0138]-[0139].) More specifically, para. [0139] of Applicants’ Published Application states that “the encapsulation step involves placing the components in a mould, which is then filled with a biocompatible material.” Para. [0139] then provides further examples of the material that may be used to fill the mould. In view of these explicit teachings of Applicants’ specification, Applicants assert that the term “encapsulating” recited in claim 17 is sufficiently enabled.

8. Furthermore, Applicants specification clearly discloses “a housing of an implantable component” as recited in claim 48. (See e.g., Applicants Published Application, FIGS. 1a and 1b; paras. [0105]- [0106] and [0032]-[0036]. Because the housing is clearly shown in the figures and because the antenna component is used in an **implantable component** throughout the specification, Applicants assert that the phrase “a housing of an implantable component” is sufficiently enabled.

9. Therefore, in light of the sufficient information identified above in the present specification, Applicants assert that the claimed invention is enabled and rejections are thus improper. Accordingly, reconsideration and withdrawal of the rejections is requested. If the Examiner

disagrees with the above assertions, Applicants respectfully request that the Examiner provide specific reasons explaining why the above phrases are not enabled rather than conclusory statements. Without such explanation, Applicants find it difficult to respond to the Examiner's rejections to the above claims.

Claim Rejections Under 35 U.S.C. §112, Second Paragraph

10. The Examiner has rejected claims 6-8, 17 and 68 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully disagree.

11. According to MPEP § 2173.02, regarding indefiniteness,

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

(Emphasis added.)

12. In the Office Action, the Examiner appears to assert that the phrase “removably mounting the feedthrough member to a work space member” is indefinite. (See, Office Action, pg. 3.) Specifically, the Examiners asserts that is not clear “[w]hether or not [the] ‘feedthrough’ [is] being removed from the workspace or not? *It appears that limitation of claims 3 should have been incorporated in prior to the positioning step of claim 1 because for the positioning and other steps to be functioned the mounting of the feed-through member must be done in the beginning of all process steps.*” (See, Office Action, pg. 3; emphasis added.) Applicants respectfully assert that the Examiner has misconstrued claim 3.

13. As noted, Applicants' claim 1 recites, in part “positioning a feedthrough member relative to an antenna template.” (See, Applicants' claim 1, above.) Applicants assert that “removably mounting the feedthrough member to a workspace member” as recited, in part, in claim 3, is part of one method for “positioning a feedthrough member relative to an antenna template,” and is not a

step that necessarily preceeds the steps currently recited in claim 1. Rather, there are many ways to “position” a feedthrough relative to an antenna template. For example, it is possible to “position” a feedthrough relative to an antenna template without using a “workspace member.” As such, Applicants assert that claim 3, which further defines the “positioning” step of claim 1, is sufficiently clear. Therefore, Applicants assert that the rejection to claim 3 under 35 U.S.C. §112 should be reconsidered and withdrawn.

14. Furthermore, according to the Examiner, the language ‘to be mounted on one of either a chassis and wall of a housing’ (claim 6, line 2-3) [is] not [a] positive limitation, as to how the first and second portions each can be mounted to either of a chassis and housing because in claim 1, the first and second portions already mounted to a feedthrough member. (*See*, Office Action, pg. 3.) Applicants disagree. Applicants assert that when considering the claim as a whole, the apparatus limitations of the “configured to be mounted on one of either a chassis and wall of a housing” are permissible positive limitations defining the structural limitations of the feedthrough member. In particular, this phrase specifically defines the configuration of the first and second portions of the feedthrough member, (i.e., the location of the mounting of the feedthrough member). Therefore, Applicants assert that the rejection to claim 6 under 35 U.S.C. §112 should be reconsidered and withdrawn.

15. Further, according to the Examiner, “[i]t is not clear as to what being referring as “the feedthrough provide a hermetically sealed...” (claim 68, line 2-3).” Although unclear from the above, it appears that the Examiner is objecting to the use of the term “hermetically sealed.” However, Applicants assert that hermetic sealing is a well known term of art. Specifically, as understood by one of ordinary skill in the art, a **hermetic seal**, for practical purposes, is considered an airtight seal, intended to secure against the entry of liquids, microorganisms, and other foreign bodies. Therefore, because the terminology objected to by the Examiner is well known, Applicants assert that the rejection of claim 68 under 35 U.S.C. § 112, second paragraph, is improper and should be withdrawn.

Drawings Objection

16. The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) for allegedly failing to show every feature of the invention specified in the claims. (*See*, Office Action, pg. 3.) In

particular, the Examiner indicated the “claimed subject matter i.e., “first and second portions each configured to be mounted on either one of a chassis and wall of a housing if an implantable component”, (claims 6-8) and “the feedthrough member is configured to provide a hermetically sealed electrical connection through a housing of an implantable component.” (claim 68), must be shown or the feature(s) canceled from the claim(s). Applicants respectfully disagree.

17. Applicants assert that the features of claims 6-8 and 68 are shown in the drawings. For instance, the drawings include a housing 14 having a chassis and wall, a feedthrough member 11 comprising a first portion 15 and a second portion 16, and a wire 18, as shown in Figures 1a and 1b. (*See*, Applicants Published Application, paras. [0016] and [0107]; FIGS. 1a and 1b.) Moreover, the drawings show, according to Fig. 1a, “both of the portions 15, 16 have a plurality of conductive posts extending through an electrically insulating block that **hermetically seals the housing 14**. In the depicted embodiment, the **feedthrough member 11** is usable for both the wires feeding back from the electrodes [] of an intracochlear array and the wire or wires that will comprise the antenna coil.” (*See*, Applicants Published Application, paras. [0016] and [0107]; FIG. 1a.)

18. Therefore, Applicants submit that the Examiner’s objections to the drawings are improper, and should be withdrawn.

Claim Rejections Under 35 U.S.C. §102

19. The Examiner has rejected claims 1, 5 and 10-12 under 35 U.S.C. 102(b) as being anticipated by GB2166005 to Miura. For at least the following reasons, Applicants respectfully disagree.

Claim 1

20. Applicants respectfully remind the Examiner that MPEP § 2131 emphasizes that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) . . . ***“The identical invention must be shown in as complete detail as is contained in the . . . claim.”*** (*See, Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (Emphasis added).)

21. Applicants' claim 1 is directed to a "method of forming an antenna configured to be implanted in a recipient, comprising: positioning a feedthrough member relative to an antenna template." (See, Applicants' claim 1, above.) Applicants assert that Miura fails to disclose any type of "feedthrough member" or "positioning" such a member relative to any other element. Rather, Miura only describes an inductance element and method of manufacturing the same for use on the surface of a chip substrate (i.e., for use in integrated circuits). (See, Miura, pg. 3, lns. 78-83.)

22. Furthermore, Miura also fails to disclose any type of element "configured to be implanted in a recipient" as recited, in part, in Applicants' claim 1. Specifically, as noted, Miura merely describes an inductance element supported on a circuit substrate for forming a hybrid integrated circuit, such as a semiconductor element, a chip capacitor, etc. (See, Miura, pg. 3, lns. 68-83.) As would be appreciated by one of ordinary skill in the art, such a device as formed by Miura would not, and could not, be implanted in a recipient because such implantation would cause malfunctioning of the device as well as expose the recipient to contamination and other detrimental effects.

23. Moreover, Miura fails to disclose **"connecting a first portion of at least one electrically conducting wire to the feedthrough member . . . and connecting a second portion of the at least one wire to the feedthrough member"** as recited, in part, in claim 1. Rather, as shown in Fig.4, the inductance element according to Murai comprises "a circuit substrate 7, **conductive paths 8 and 9** and a coil portion 10 formed by insulated winding 12 wound around a spool member 11." (See, Miura, pg. 3, lns. 68-83.) In particular, "[t]he conductive paths 8 and 9 are formed on a major surface of the circuit substrate 7 in desired patterns," such that the insulated winding 12 has a connecting portion to the conductive path 8 and separately to conductive path 9. (See, Miura, pg. 3, lns. 68-83.) Furthermore, the Examiner has not shown or explained how the conductive paths 8 and 9 are equivalent to the feedthrough member of claimed invention.

24. For at least the reasons discussed above, Applicants assert that Miura fails to anticipate or render obvious all elements of Applicants' claim 1. Therefore, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. §102 be reconsidered, and that it be withdrawn.

Claim Rejections Under 35 U.S.C. §103

25. The Examiner has rejected claims 14-15 under 35 U.S.C. 103(a) as being unpatentable over Miura. Applicants respectfully assert that, for at least the reasons discussed above with reference to claim 1, the rejections under 35 U.S.C. §103 are improper. In particular, Applicants assert that Miura fails to teach that which is asserted by the Examiner. As such, Applicants respectfully submit that the rejections under 35 U.S.C. §103 are improper and should be withdrawn.

Dependent Claims

26. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicants respectfully assert that the dependent claims are also allowable over the art of record.

Conclusion

27. In view of the foregoing, Applicants respectfully submit that this application is now in condition for allowance. A notice to this effect is respectfully requested.
28. Applicants make no admissions by not addressing any outstanding rejections or basis of rejections. Furthermore, Applicants reserve the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application. Thus, cancellations and amendments of above claims should not to be construed as an admission regarding the patentability of any claims.

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Respectfully submitted,

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